

REMARKS

Claims 1-10 and 13-23 are pending in the case.

Claims 2-4, 6-7, 14-16 and 18 have been rejected under 35 U.S.C. 112, second paragraph, for indefiniteness, predominantly due to alleged antecedence issues. While Applicant does not concede that these claims are indefinite, in order to expedite prosecution Applicant has amended the claims in an effort to address the issues raised by the Examiner. If the Examiner deems that further amendment is necessary, the courtesy of a telephone interview is respectfully requested.

Claims 1-9, 13-20 and 22-23 have been rejected under 35 U.S.C. 102(b) as being anticipated by Grinshpun (U.S. Patent No. 6,226,943). Claims 10 and 21 have been rejected under 35 U.S.C. 103(a) as being obvious over Grinshpun combined with Berdan, II (U.S. Patent No. 6,042,911).

Applicant does not concede that these rejections are proper, and in particular does not agree that certain terms that the Examiner construes as "functional language and not structural limitations" should not be given patentable weight, and reserves the right to address these issues during further prosecution. However, in order to expedite prosecution Applicant has amended claims 1 and 13. Claim 1 has been amended to recite that the insulation product comprises a single unitary insulating member formed of a single rigid insulating material, and that the slots extend width-wise into this single rigid insulating material. Claim 13 has been amended to clarify how the wood member is mounted on the insulating member, i.e., that it is bonded to the insulating member on a second side of the member opposite the side that includes the slots.

With regard to claim 1, Grinshpun describes a panel having grooves that are formed of a resilient, compressible material that is different from the material of which the rest of the panel is formed. These compressible portions are an essential feature of the Grinshpun, allowing a tight fit around a support member received in the groove. The compressible portions also allow the support members to be inserted into the groove without tearing the foam. (Grishpun, col. 3, lines 52-63.) Accordingly, eliminating the compressible portions would constitute a wholesale reconstruction of the Grinshpun system.

Nothing in Berdan, cited for its teaching of slots spaced at 24 inch intervals, describes a conformable mineral fiber batt and thus would not have suggested such a modification of the Grinshpun system.

With regard to claim 13 (and also with regard to claim 6, which depends from claim 1), the wood members 20 disclosed in Grishpun, which the Examiner cites at page 5 of the office action, are neither bonded to the insulating member nor are they disposed on a side of the insulating member opposite to the side having the slots. Instead, the wood members 20 are inserted into the slots in the insulating member. Thus, Applicant respectfully submits that claim 13 as amended is clearly patentable over Grishpun.

Applicant respectfully submits that the amended claims are patentable over the art of record, and respectfully requests allowance.

Withdrawn claim 24 has been amended to include all of the structural limitations of claim 13, which is believed to be allowable, and thus rejoinder is respectfully requested.

It is believed that no fees are due with this submission. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 10189-002001.

Respectfully submitted,

Date: March 25, 2008

/Celia H. Leber/
Celia H. Leber
Reg. No. 33,524

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906